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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURT THIES

Appeal 2010-012444
Application 10/769,210
Technology Center 1700

Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH, and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

Opinion for the Board filed by GUEST, *Administrative Patent Judge*.

Opinion Concurring-in-part and Dissenting-in-part filed by
SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision to reject claims 3-14 under 35 U.S.C. § 112, second paragraph, as indefinite as lacking positive steps delimiting a process and under 35 U.S.C. § 101 as failing to recite a statutorily recognized process. Claims 1-14 are also rejected under 35 U.S.C. § 102(b) as anticipated by or, in the

alternative, under 35 U.S.C. § 103(a) as unpatentable over Jederström (US 4,997,867; issued Mar. 5, 1991).¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellant's invention relates to dry beads that swell rapidly when placed in contact with aqueous media by incorporating a highly water soluble diluent. Claims 1, 3, 4, and 11 are illustrative:

1. Polymer bead of dry bead structure incorporating a diluent that is highly water-soluble characterized by swelling rapidly when placed in contact with aqueous media to form a water-swollen gel bead.

3. A method of making the beads of claim 1 by water-in-oil process.

4. The method of making the beads of claim 1 by the droplet extrusion method.

11. The method of using the beads of claim 1 in accordance with transporting water-swollen gel beads through an animal circulatory system.

We adopt the Examiner's findings in the Answer as our own and add any additional findings of fact appearing below for emphasis.

II. INDEFINITENESS

A. ISSUE ON APPEAL

A first issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the

¹ The Examiner has withdrawn the rejection of claims 1 and 2 under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Cohen (Ans. 3).

Examiner erred in concluding that claims 3-14 are indefinite for failing to recite a positive method step? We answer this question in the negative.

B. DISCUSSION

Claims 3 and 4 recite a method of making the beads of claim 1 by a “water-in-oil process” and “the droplet extrusion method,” respectively; claims 5-10 depend from either claim 3 or claim 4; and claims 11-14 recite a method of using the beads of claim 1.

The Examiner contends that claims 3-14 do not recite a positive step. We agree. *See Ex parte Erlich*, 3 USPQ2d 1011, 1017 (Bd. Pat. App. & Int. 1986) (“While . . . the claims need not recite all of the operating details, we do find that a method claim should at least recite a positive, active step(s) so that the claim will ‘set out and circumscribe a particular area with a reasonable degree of precision and particularity,’ and make it clear what subject matter [the] claims encompass, as well as making clear the subject matter from which others would be precluded.”) (citations omitted). Thus, as pointed out by the Examiner, it is unclear what, if any, steps are included or excluded by claims 3-14. (Ans. 4). That is, the metes and bounds of claims 3-14 cannot be determined.² *See Allen Eng’g Corp. v. Bartell Indus. Inc.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002) (quoting *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998))

² We recognize that claims 11-14 recite an action, i.e., “transporting,” “absorbing,” or “carrying.” However, the transitional phrase “in accordance with” in claims 11-14 creates an ambiguous relationship between the recited “method of using the beads” and the acts of “transporting” in claims 11 and 12, “absorbing” in claim 13, and “carrying” in claim 14. Thus, it is unclear whether the acts of “transporting,” “absorbing,” and “carrying” recited in claims 11-14, respectively, constitute steps in the recited method.

(“In determining whether the claim is sufficiently definite, we must analyze whether ‘one skilled in the art would understand the bounds of the claim when read in light of the specification.’”).

The Appellant presents substantially the same argument with respect to claims 3-14. Namely, this argument is that the claimed methods are set forth in detail in the Specification and that the claims are properly interpreted in light of the Specification as they would have been interpreted by one of ordinary skill in the art (Br. 3-4; Reply Br. 1). Therefore, according to the Appellant, the claims are definite under § 112, second paragraph.

We agree with Appellant that the claims must be read in light of the Specification. *See e.g., In re Moore*, 439 F. 2d 1232, (1971) (“the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art”).

However, “‘reading a claim in the light of the specification,’ to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d 1393, 1395-1396 (CCPA 1969). The court in *In re Prater* determined that the claims did not meet the requirements of 35 U.S.C. § 112, second paragraph, since without the improperly imported limitations from the specification, the claim “reads on subject matter for which appellants do not

seek coverage, and therefore tacitly admit to be beyond that which ‘applicant regards as his invention,’” *Id.* at 1396; *see also In re Cormany*, 476 F. 2d 998, 1001 (CCPA 1973). The situation in *In re Prater* is exactly the situation here. Appellant seeks us to import the necessary steps disclosed in the Specification so as to limit the claimed processes to that which they regard as their invention. We decline to do so.

35 U.S.C. § 112, second paragraph requires Applicant to “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The statute “puts the burden of precise claim drafting squarely on the applicant.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). During patent prosecution an applicant has the opportunity to amend the claims in order to overcome indefiniteness rejections. *Exxon Research and Eng’g Co. v. U.S.*, 265 F.3d 1371, 1380 (Fed. Cir. 2001) (*citing In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

For example, if Appellant intends to claim the water-in-oil and/or the droplet extrusion methods specifically disclosed in Appellant’s Specification, then the claims should recite the particular steps disclosed in the Specification. It is a fundamental principal of claim interpretation that it is improper to read limitations from the Specification into the claims when such limitations are not positively recited. “[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (“Van Geuns cannot read an NMR limitation into claim 42 to justify his argument as to the meaning of the “uniform magnetic field.”); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005)

(“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”).

For the reasons set forth above, we agree with the Examiner that claims 3-14 do not meet the requirements of 35 U.S.C. § 112, second paragraph, in that, while purporting to be drawn to processes that are disclosed only in Appellant’s Specification, they fail to set forth any discernable method steps to limit the scope to those processes. Thus, claims 3-14 do not particularly point out and distinctly claim the subject matter which the Appellant regards as his invention.

Considering the Examiner’s additional rejections of claims 3-14 would necessarily require that we speculate or make assumptions as to what is intended by the claims. Thus, we sustain the Examiner’s rejection of claims 3-14 under 35 U.S.C. § 112, second paragraph, and procedurally reverse the examiner’s rejections under 35 U.S.C. § 101 and § 102(b)/§ 103(a) with respect to claims 3-14. *See In re Wilson*, 424, F.2d 1382, 1385 (CCPA 1970); *In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

III. ANTICIPATION/OBVIOUSNESS

Appellant’s arguments are directed to all of the rejected claims as a group, emphasizing limitations found in claim 1 (Br. 9-13). Accordingly, we decide the following issue on Appeal on the basis of representative claim 1.

A. ISSUE ON APPEAL

A second issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant’s view that

the Examiner erred in finding that Jederström teaches a polymer dry bead structure incorporating a diluent as recited in claim 1? We answer this question in the negative.

B. DISCUSSION

Appellant contends that the reference does not disclose dry polysaccharide bead particles comprising a highly soluble diluent. Appellant recognizes polyethylene glycol as a diluent present in an aqueous medium into which the disclosed polysaccharide beads are placed (Br. 11). According to Appellant, the dry beads are produced in the absence of highly soluble water diluents, and the polyethylene glycol performs a totally different function than the claimed diluent (Br. 12).

Appellant's arguments, however, do not address the reasoning supporting the Examiner's specific rejection. The Examiner finds that Jederström discloses dextran as one of the polysaccharides used to form the polymer bead particles (Ans. 5 and 7; *see* Jederström, col. 1, ll. 10-26). The Examiner finds that Appellant's Specification defines dextran as a "suitable highly water-soluble diluent" (Ans. 5 and 7; *see* Spec. 4:19-28). Thus, the Examiner concludes that "it is the beads themselves that anticipate the present claims, not the aqueous solution containing the beads" (Ans. 7). In other words, the Examiner does not rely on the polyethylene glycol aqueous solution as the "diluent" of claim 1, but rather the dextran, of which the bead is made.

Claim 1 is directed to a polymer bead "incorporating a diluent that is highly water-soluble" (claim 1). Thus, we agree with the Examiner that a bead made from dextran (a polysaccharide) would constitute a polymer bead

incorporating a highly water-soluble diluent, since dextran is identified by Appellant as a highly water-soluble diluent. The term “incorporating” is being interpreted by the Examiner to be equivalent to “comprising” language. The claim requires no additional polymer bead structure other than the polysaccharide (polymer) that is also a highly water-soluble diluent. We find the Examiner’s interpretation to be reasonable and substantially un rebutted by Appellant.

Although Appellant’s Reply Brief states that the Examiner has “switched the ground of rejection . . . for the first time” in the Answer, Appellant nonetheless relies upon the arguments presented in the Appeal Brief and presents no further arguments to rebut the Examiner’s allegedly new rejection (*see* Reply Br. 4). Appellant has been fully apprised of the Examiner’s position and has had the opportunity to rebut the Examiner’s findings and claim interpretation in the Reply Brief. Appellant has chosen not to do so.

Thus, we find that claims 1 and 2 are anticipated by the teachings of Jederström.

IV. CONCLUSION

On the record before us and for the reasons discussed above, we:

1. sustain the Examiner’s rejection of claims 3-14 as being indefinite under 35 U.S.C. § 112, second paragraph;
2. procedurally reverse the Examiner’s rejection of claims 3-14 under 35 U.S.C. § 101 and 35 U.S.C. § 102(b)/103(a);
3. sustain the Examiner’s rejection of claims 1 and 2 under 35 U.S.C. § 102(b)/§ 103(a).

V. DECISION

We affirm the Examiner's decision.

VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

SMITH, *Administrative Patent Judge, concurring-in-part and dissenting-in-part.*

I respectfully dissent from the majority's decision to affirm the rejection of claims 3-14 under 35 U.S.C. § 112, second paragraph. I would reverse the rejection of claims 3-14 under 35 U.S.C. § 101 for reasons that differ from the majority. I concur in the majority's decision to affirm the Examiner's rejections of claims 1 and 2 under 35 U.S.C. §§ 102(b) & 103(a).

I do not agree with the majority view that the subject matter of claims 3 and 4 is indefinite. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the meaning of the terms a "water-in-oil process" and a "droplet extrusion method" in light of the Specification, 35 U.S.C. § 112, second paragraph, is satisfied. The objected to expressions may very well be broad, but the same or substantially the same expressions appear in the Specification and several representative processes are exemplified therein. In the absence of reasons why these exemplified processes would include inoperative embodiments for the Appellant's purposes, the representation set forth in the Specification of processes included within these broad expressions are deemed adequate. In my opinion, a person skilled in this art would be well aware of what is intended thereby. Similarly, the absence of a recitation of minimum steps does not render the claims indefinite. It is clear that the claims reflect what

the Appellant regards as his invention in this connection. That is, the method of making a polymer bead by a water-in-oil process and/or a droplet extrusion method. There is no uncertainty as to what is intended.

Having determined that the subject matter of claims 3-14 describes a proper process/method, I would also reverse the Examiner's rejection of claims 3-14 under 35 U.S.C. § 101.

In responding to the rejections under 35 U.S.C. §§ 102(b) & 103(a), Appellant did not separately argued the patentability of claims 3-14. Consequently, I would further affirm the Examiner's rejections of claims 3-14 under 35 U.S.C. §§ 102(b) & 103(a).

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